

REMARKS

In the Office Action the Examiner objected to the Abstract. A new Abstract has been submitted for approval by the Examiner. The Specification has now been checked and appropriate corrections have been requested in the above-amendment. Applicants believe that now new matter has been added by these amendments.

The Examiner rejected Claim 17 under 35 U.S.C. § 102(b) as having been anticipated by **Kato et al.** (U.S. Patent No. 4,662,124). Applicants respectfully traverse this rejection. The claim in question call for a tool with a sharp edge with an angle of less than about 70°. The Examiner contends that **Kato et al.** shows such a tool. The cited reference details a method of grinding sapphire wafers along their R plane to minimize warpage. Figure 3, to which the Examiner refers, shows such a wafer with the invisible C planes shown as diagonal lines 3. These planes are microscopic and invisible. Lines 3 are merely imaginary representations of these planes. Applicants respectfully suggest a careful examination of this figure that the Examiner contends contains a sharp edge with an angle that is less than about 70°. The upper left hand edge of the figure (where the imaginary plane is extended to demonstrate the 57.6° relationship) clearly has a right angle (90°) corner. The right hand edge of the wafer might appear to follow the C plane. Because the imaginary extension of the upper left edge shows an angle of 57.6°, simple geometry tells us that the upper right hand

edge must have an angle of  $122.4^{\circ}$  (*i.e.*,  $180^{\circ}$  minus  $57.6^{\circ}$ ). Thus, Fig. 3 does not show the required sharp edge. Of equal importance is that the claim in question requires that the sharp edge be formed between "a working plane and a cleavage plane parallel to a plane R." In Fig. 3 the top surface or working plane is parallel to the plane R (see abstract). Therefore, even if the wafer of Fig. 3 showed a sharp edge, which it does not, the claim would not be met because the plane parallel to plane R is formed by grinding and not by cleavage as is required by the claim. Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. § 102(b) based on **Kato et al.** since that reference plainly does not show each and every element of the claimed invention.

The Examiner rejected Claims 20 and 21 under 35 U.S.C. § 102(a) as having been anticipated by **Morita et al.** (U.S. Patent No. 5,753,966). Applicants has previously traversed a 35 U.S.C. § 102(e) rejection of these claims based on this same reference. Applicants respectfully traverse the Examiner's renewed rejection under 35 U.S.C. § 102(a). For a rejection under § 102(a) the invention must have been known or used by others or patented or described in a **printed** publication in this or a foreign country **before** the invention by applicant. The Examiner has provided no evidence of knowledge or use in this country. Therefore, it would appear that the Examiner is basing the rejection on description in a **printed** publication. Applicants respectfully point out that a Japanese patent application is **not** a printed publication. Like virtually the

entire world (now that U.S. procedure has been harmonized) the Japanese procedure is that patent applications are confidential until they are "laid open" for public inspection. This process occurs by publication (Kokai) 18 months following the actual application date. Applicants have supplied a page from a popular Industrial Property Manual attesting to this procedure. The foreign filing date (December 1995) is not the Kokai date which would have occurred on or about June 28, 1996 for the earliest priority application. If the Examiner contends that the Kokai date was uncharacteristically early (*i.e.*, prior to Feb. 29, 1996—Applicant's perfected priority date), Applicants respectfully request a copy of that Kokai document showing the early date. Otherwise Applicants respectfully request that the rejections of Claims 20 and 21 be withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested. If for any reason the Examiner still finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 337-6700 to discuss the steps necessary for placing the application in condition for allowance.

You are hereby authorized to charge any fees due and refund any surplus fees to our Deposit Account No. 50-1314.

Respectfully submitted,

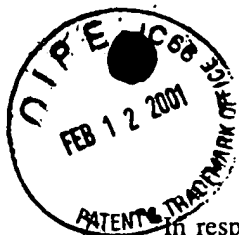
HOGAN & HARTSON L.L.P.

Date: 7-Feb.-01

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Attachment: Page 5 of Japan entry from Manual of Industrial Property.



In respect of a divisional application, or an application converted from a utility model application or a design application, a request for examination can be made within a non-extensible period of 30 days from the date on which such application has been filed, even after lapse of the said period of seven years. It should be noted in this respect that in case of a divisional or a converted application the seven-year term runs from the date of filing in Japan of the parent or original application.

(Note that under the law applicable prior to November 1, 1985, if new matter had been introduced by amendment in an application which had been dismissed in that application, a new patent application could be filed based on such dismissed amendment and incorporating the new matter, which new application would be deemed to have been filed at the date of submission of the new matter. In such case the seven-year term for requesting examination would run from the date of filing of the amendment concerned, provided that the request for examination could be made within 30 days from filing the new application even after lapse of said seven-year term. It must be noted, however, that the possibility of filing such new application – whereby such application was deemed to have been filed at the date the new matter had been submitted – has become abolished under the amended law as in force from November 1, 1985. Thus, a new patent application cannot be filed based on such dismissed amendment submitted on or after said date).

If the request for examination is not filed within the prescribed period, the application will be deemed to have been withdrawn.

The fact that a request for examination has been filed is published in the Patent Gazette. In case a third party has filed a request for examination, the applicant will be informed of such fact.

Once it has been filed, a request for examination cannot be withdrawn (but as a matter of course the application itself could be withdrawn).

In principle, the examination of patent applications will be carried out in order of the receipt of the requests for examination.

Only under special circumstances a preferential examination or accelerated examination can be requested; see hereinafter, item 4.

2. Pre-examination publication (Kokai). Apart from the course of the procedure of grant and irrespective of whether a request for examination has been made or not, as far as the contents of the application are not considered liable to injure public order or morality, each patent application is laid open to public inspection upon lapse of a period of 18 months from the date of filing of the application, or from the earliest priority date in case a Convention priority or an internal priority is claimed (unless such application has already been published after full examination of same). The method of divulgation of a patent application consists in that the full text of specification, claims and drawings (with amendments, if any) are printed in the Patent Gazette.

3. Effect of provisional publication. After an application has been laid open to public inspection, the applicant has a right to compensation from any third party who is working the invention sought to be patented, but this right cannot be exercised until:

a) in the case of applications filed before January 1, 1996, in respect of which a decision for post-examination publication (see hereafter, item 6.) had been made before that date: after the post-examination publication; and

b) in the case of applications filed after January 1, 1996, and in the case of applications filed before that date in respect of which no decision for post-examination publication had been made before January 1, 1996: after grant of the patent.

In order to demand payment of any compensation, the applicant must in advance warn the third party working the invention by a document describing the contents of the application, or the applicant must be able to prove that such third party worked the invention with the knowledge that it is an invention claimed in the application that has been laid open to public inspection. The amount of the compensation is equal to the

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